

## **REMARKS**

In response to the above-identified Office Action, Applicant amends the application and seeks reconsideration thereof. In this response, Applicant amends claims 1 and 12. Applicant does not cancel or add any new claims. Accordingly, claims 1-17 are pending.

### **I. Objections to the Drawings**

The Examiner objected to the drawings under 37 C.F.R. § 1.84(p)(5) because the drawings do not include reference signs mentioned in the description. Applicant submits herewith a replacement drawing for Figure 1 utilizing reference number 106 mentioned in the specification. Accordingly, reconsideration and withdrawal of the objection to the drawing are requested.

### **II. Objection to Claims**

Claims 1-17 are objected to for including an informality in the phrase "at least one of the criterion" which occurs in claims 1 and 12. Applicant has amended this phrase in claims 1 and 12 as suggested by the Examiner to state "at least one of the criteria." Accordingly, reconsideration and withdrawal of the objection to the claims are requested.

### **III. Claims Rejected Under 35 U.S.C. § 102**

Claims 1-4, 10-15 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,668,966 issued to Ono, et al. (hereinafter "Ono"). Applicant respectfully disagrees for the following reasons.

It is axiomatic that to anticipate a claim, the Examiner must show that each element of a claim is taught by a single reference. In regard to claims 1 and 12, these claims include the elements of "defining a library of available criteria" and "accepting an indication of a tier of the filter to which a selected criterion is to be associated." The Examiner cites the Abstract and col. 4, lines 53-59 of Ono as teaching "defining a library of available criteria." Applicant has reviewed the cited sections of Ono and has been unable to discern any part therein that teaches defining a library of available criteria. Rather, Ono teaches that primitive predicates may be created using a predicate creation system. See col. 10, lines 21-24 of Ono. The predicate creation system requires the user

to select a "create primitive" command in a menu. The "create primitive" command allows users to input attributes such as search conditions or key words into an attribute field to create a predicate to be displayed as an icon. See col. 10, lines 47-64 of Ono. Thus, Applicant has been unable to discern any part of Ono that teaches to define a library of available criteria. Rather, the cited sections of Ono appears to require that a user create each predicate individually using this creation system. Thus, the system of Ono requires a user to create predicates by defining the predicates and does not offer a set of predicates predefined in a library. The Examiner has not indicated and Applicant has been unable to discern any part of Ono that teaches collecting the user defined predicates into a library. Applicant invites the Examiner to identify which part of Ono teaches providing or creating a library of predicates. Therefore, Applicant believes Ono does not teach defining a library of criteria.

Further, the Examiner cites Figure 4B in support of his assertion that an indication of a tier of the filter is taught by Ono because the Examiner asserts that Ono teaches choosing a particular composite predicate in which to place a simple predicate from among those shown in a tree structure of Figure 4B. This description of Figure 4B is inaccurate. Figure 4B is merely a conceptual representation of a composite predicate and it is not a graphical representation shown to a user. See col. 9, lines 28-34 of Ono. Rather, the graphical representation taught by Ono is a nested folder structure shown in Figure 4C. See col. 9, lines 35 and 36. Applicant has been unable to discern any part of Ono that teaches a tree structure presented as a graphical representation to a user such that it might be used to indicate a placement of a primitive predicate in a composite predicate. Rather, Ono states clearly that the nested folder structure of Figure 4C is displayed on a desktop to a user. See col. 9, lines 35 and 36 of Ono. A nested folder structure as graphically represented to a user is not a tiered structure. Thus, Ono does not teach accepting an indication of a tier of the filter to which a selected criterion is to be associated. Rather, primitive predicates may be constructed into composite predicates and logical expressions by placing predicates in folders which represent logical operations. See col. 8, lines 4-15 of Ono. Thus, the Examiner has not established that Ono teaches each of the elements of claims 1 and 12.

Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 1 and 12 are requested.

In regard to claims 3 and 14, these claims depend from claims 1 and 12 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1 and 12, these claims are not anticipated by Ono. Further, these claims include the elements of "applying an AND to those criteria residing on different tiers of the filter." Applicant has been unable to discern and the Examiner has not specifically identified any part of Ono that teaches these elements. Rather, Ono teaches applying an AND to predicates in the same window. See Figure 13 of Ono. Also, the Examiner has not identified any part of Ono that teaches a graphical display of a *tier*. Thus, the Examiner has failed to establish Ono teaches applying an AND across different tiers. Applicant invites the Examiner to specifically identify where Ono teaches an AND operation applied across different tiers and to clarify what the Examiner believes in Ono teaches tiers. Accordingly, reconsideration and withdrawal of claims 3 and 14 are requested.

In regard to claims 2, 4, 7, 10, 11, 13, 15 and 17, these claims depend from independent claims 1 and 12 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to independent claims 1 and 12, these claims are not anticipated by Ono. Accordingly, reconsideration and withdrawal of the anticipation rejection of these claims are requested.

#### **IV. Claims Rejected Under 35 U.S.C. § 103**

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono. Applicant respectfully disagrees for the following reasons. To establish a *prima facie* case of obviousness, the Examiner must show that the cited reference teaches or suggests each of the elements of the claims. In regard to claims 5 and 6, these claims include the elements of "a tally of the list of items of interest" and "displaying a tally of the list." The Examiner admits that Ono does not explicitly teach a numerical tally. In fact, the Examiner has not provided any citation to any part of Ono on which to base his rejection. Rather, the Examiner proposes a modification to include tallying of listed items without any support from the cited reference. The Examiner argues that it would have been obvious to provide such a tally so that "a user will have a better

appreciation of the magnitude of what the 'filter' has found." However, the Examiner provides no support from any reference for this bold assertion. Applicant has been unable to discern any part of Ono that teaches the benefit of the use of a tally. Therefore, the Examiner has failed to establish that the cited references teaches or suggests each of the elements of claims 5 and 6 or that a motivation to modify the cited reference is taught or suggested by Ono. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 5 and 6. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 5 and 6 are requested.

**V. Allowable Subject Matter**

Applicant notes with appreciation that the Examiner has indicated that claims 8, 9 and 16 are allowable over the prior art that has been made of record. For the reasons set forth above, Applicant now believes that these claims are now in condition for allowance. Accordingly, reconsideration and withdrawal of the objection to claims 8, 9 and 16 are requested.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-17 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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Thomas M. Coester, Reg. No. 39,637

12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, California 90025  
(310) 207-3800

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 28, 2004.



Lillian E. Rodriguez

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